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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Arthur Dale Burns
Serial No.: 09/603,510
Filed: June 26, 2000
Title: STUDENT LOAN CONSOLIDATION QUALIFICATION SYSTEM
AND METHOD OF OPERATION THEREOF
Grp./A.U.: 3624
Examiner: Alain L. Bashore

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313, on <u>06/25/03</u> (Date) <u>Stephane Pitt</u> (Printed or typed name of person signing the certificate) <u>Stephane Pitt</u> (Signature of the person signing the certificate)
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Sir:

REQUEST FOR RECONSIDERATION OF EXAMINER'S ACTION

The Applicant has carefully considered this application in connection with the Examiner's Remarks mailed May 28, 2003, and respectfully requests reconsideration of this application in view of the following remarks.

The Applicant originally submitted Claims 1-22 in the application. The Applicant has not amended, canceled or added any claims herein. Accordingly, Claims 1-22 are currently pending in the application.

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I. Rejection of Claims 1-8 and 16-22 under 35 U.S.C. §101

The Examiner has rejected Claims 1-8 and 16-22 under 35 U.S.C. §101 as being directed to a non-statutory subject matter. As best understood by the Applicant, the Examiner evidently believes the Applicant is taking the position that software is being claimed that is not associated with a "computer readable medium." This is not the Applicant's position. It is well known to those skilled in the pertinent art that a computer program embodied in software, such as that described in the present application, is always employed in conjunction with a computer readable medium. The application is clear that the Applicant recognizes that such is the case, as evidenced by use of the term "presents at least one page" in the claims. The only possible interpretation of such term by those skilled in the pertinent art is that the "one page" is produced by some form of a computer readable medium, such as a computer screen or computer printed page or similar means. Thus, the Applicant is of the belief that the Examiner's requirement that software must be claimed in conjunction with physical matter is already satisfied. The Applicant, therefore, disagrees with the Examiner's conclusion that Claims 1-8 and 16-22 are directed toward non-statutory subject matter and respectfully requests the Examiner to withdraw the rejection of Claims 1-8 and 16-22 under 35 U.S.C. §101.

II. Rejection of Claims under 35 U.S.C. §103

The Examiner rejected Claims 1-22 under 35 U.S.C. §103(a) as being unpatentable over Tengel, *et al.*, U.S. Patent No. 5,940,812 (Tengel), in view of Levine, *et al.*, U.S. Patent No. 6,233,566B1 (Levine), and Mottola, *et al.*, U.S. Patent No. 5,745,885 (Mottola).

Tengel describes a loan origination system for matching loans with a potential borrower via a telecommunications network. The system employs a borrower database that gathers and stores information furnished by a potential borrower as well as credit information regarding the borrower supplied by a credit bureau. The system has a loan origination database in which one or more potential lenders have stored loan acceptance criteria and the attributes of their loans. The system compares the borrower attributes and the loan acceptance criteria to determine which of these loans are available to the potential borrower and ranks such loans for the borrower to make a choice. After the borrower chooses a loan, borrower attributes in the database are used to automatically generate a loan application that is sent to the lender for approval. (Abstract).

Tengel is directed to gathering of information with respect to the issuance of new loans and provides no guidance or insight with respect to combining or refinancing existing loans. Tengal does not directly or indirectly address or suggest gathering information from a loan applicant with respect to a plurality of existing and outstanding loans with a view to qualifying both the applicant and the loans for consolidation. Tengal only provides a mechanism for determining if a potential borrower has the financial wherewithal to withstand the burden of incurring a larger amount of debt and does not teach or suggest a system for reducing a borrower's financial burden by consolidating loans. In addition to not addressing student loans or loan consolidation issues, Tengal also does not address lender contact or interaction with the borrower unless and until the borrower initiates such contact. (Col. 9, lines 60-62).

The Examiner looks to Levine to overcome the shortcomings of Tengal. Levine does not do so for a number of reasons including the fact that the two references are not analogous. The references are not analogous because they deal with vastly different financial disciplines. A person

of ordinary skill in the art of lending and loan origination, such as a banker, would hardly be expected to resort to Levine in order to overcome any shortcomings in Tengal. Nor would a person of ordinary skill in the art of purchasing and selling financial instruments, such as a stockbroker, look to Tengal for teachings or suggestions with respect to financial markets. The respective areas of endeavor are quite distinct. Levine does not address any aspect of the loan business such as loan processing, loan applications, credit assessment, etc. Levine only addresses issues relating to the business of buying and selling financial products. Nothing in Levine suggests that the system described therein could be usefully employed in any aspect of the lending or debt consolidation business.

The Examiner states that Tengal and Levine are within "the same field of endeavor: financial manipulation of loans." (Office Action, para 5). In addition to disagreeing with the Examiner's position that Tengal and Levine are within the same field of endeavor, as discussed above, the Applicant also respectfully disagrees with the conclusion that both deal with the "financial manipulation of loans." Levine does not address any aspect of the issuance or manipulation of loans or loan terms. Levine addresses the marketing of financial instruments of which loans are but one type. Levine deals with loans as a product and the manipulation of a market for such loans, whereas Tengal deals with the creation or manipulation of loans and their terms that, when completed, may or may not become one such product. Stated slightly differently, Tengal addresses the field of lending and creating loans by manipulating the loan structure, whereas Levine addresses manipulating a market for investments. It is well established by those skilled in the relevant arts that the two types of endeavor are quite distinct from each other, both as to the necessary skills brought to bear as well as the subject matter itself. Tengal and Levine address

clearly defined separated fields of well recognized endeavors and to suggest otherwise is, at best, speculative. The mere fact that isolated references are found to establish a combination does not render the combination obvious unless something suggests the desirability of the combination, which is not the case here. Tengel, individually or in combination with Levine, thus fails to teach or suggest the invention recited in independent Claims 1, 9 and 16 and their dependent claims, when considered as a whole. Claims 1-22 are therefore not obvious in view of Tengel and Levine.

The system described in Mottola also does not overcome the shortcomings in Tengel. In fact, Mottola disparages student loans and uses their perceived shortcomings as justification for its alternative higher education funding plan. Mottola this teaches away from using student loans to finance a loan applicant's higher education. (Col. 1, lines 15-67; Col. 2, lines 1-13). Mottola is directed solely to a "method and apparatus for implementing and administering a plan of investments for financing higher education". (Col. 1, lines 17-18). Mottola does not include loans in the plan of investment nor does Mottola describe or suggest the consolidation of outstanding student loans.

Tengel, individually or in combination with Mottola, thus fails to teach or suggest the invention recited in independent Claims 1, 9 and 16 and their dependent claims, when considered as a whole. Claims 1-22 are therefore not obvious in view of Tengel and Mottola. In view of the foregoing remarks, the cited references do not support the Examiner's rejection of Claims 1-22 under 35 U.S.C. §103(a). The Applicant therefore respectfully requests the Examiner to withdraw the rejection.

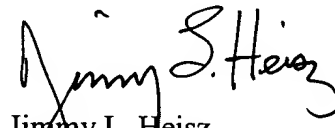
III. Conclusion

In view of the foregoing remarks, the Applicant now sees all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicits a Notice of Allowance for Claims 1-22.

The Applicant requests the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application.

Respectfully submitted,

HITT GAINES, P.C.


Jimmy L. Heisz
Registration No. 38,914

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P.O. Box 832570
Richardson, Texas 75083
(972) 480-8800